



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/172,830	10/15/1998	ALAIN ZANCO	2348-348/2.R493.42	9826

7590 04/05/2004
Ronald R. Santucci
Frommer Lawrence & Haug LLP
745 Fifth Avenue
New York, NY 10151

EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/172,830

Applicant(s)

ZANCO, ALAIN

Examiner

Ted Kavanaugh

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) 7,10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8 and 9 is/are rejected.
- 7) ☒ Claim(s) 3 and 5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 3728

DETAILED ACTION

1. In view of newly found prior art, prosecution is re-opened and the following rejections are applied.

Opening Remarks

2. Applicant is invoking 112, 6th paragraph, see the last line of page 3 of the amendment filed Nov. 7, 2001. Therefore, the term "an interlocking surface means" has been construed as referring "to other ski binding means which is capable of being locked into the notches of the binding of the boot to a ski or skate", see the paragraph bridging pages 3-4 of the reply brief filed August 21, 2002.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no antecedent basis for the "interlocking surface means allows for an automatic release binding to be coupled therewith", claim 2.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3728

5. Claims 1,2,8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4674202 (Bourque) in view of either [US 4176856 (Glaser) or US 4403789 (Hickey)].

Bourque teaches a cross-country ski boot for a ski including the sole having a first rigid part extending from the heel portion over $\frac{1}{2}$ of the length of the sole (see col. 1, lines 29-31) and a flexible front portion (see col. 1, lines 26-35 and col. 2, lines 33-36). Bourque lacks the first heel part having an interlocking surface means which interlocks with a binding of an alpine ski thus firmly fixing the first heel part against flexing with respect to the flexible portion. Glaser teaches a cross-country ski boot with the heel portion of the sole having an equivalent interlocking surface means (clasp 6 and wedge portion 5 are attached to the heel portion of the ski boot and interlocks with the binding (plate 2 having prongs 3) of the ski 1) which interlocks with a binding of an alpine ski thus firmly fixing the sole against flexing (see col. 2, lines 42-48). The interlocking means permits the ski boot to convert from a cross-country mode to a downhill mode. The ski is inherently an alpine ski when skiing downhill. It would have been obvious to provide the ski boot of Bourque with the heel portion of the sole having an interlocking surface means, as taught by Glaser, to secure the heel to the ski when the user encounters a downhill slope. Regarding claim 2, the interlocking surface means as taught above allows for an automatic release binding (plate 2 with prongs 3) to be coupled therewith, see col. 2, lines 48-51. Regarding claim 8, the clasp 6 and wedge 5 naturally have a profile and length, and the plate 2 can be attached to any part

Art Unit: 3728

of the ski and therefore is capable of engaging a ski binding irrespective of the boot size.

Hickey teaches a cross-country ski boot with the heel portion of the sole having an equivalent interlocking surface means (see col. 2, lines 51-58 and col. 3, lines 35-57 which is similar to the embodiment shown in figures 7-8 of the instant application), which interlocks with a binding of an alpine ski thus firmly fixing the sole against flexing. The interlocking means permits the ski boot to convert from a cross-country mode to a downhill mode. It would have been obvious to provide the ski boot of Bourque with the heel portion of the sole having a pin, as taught by Hickey, to secure the heel to the ski when the user encounters a downhill slope. Regarding claim 2, the interlocking surface means as taught above would also automatically release when a great enough magnitude is applied, see col. 3, lines 39-44. Regarding claim 8, the pin naturally has a profile and length and therefore has a profiled part with a standard length which engages a ski binding irrespective of the boot size, see figure 1.

Allowable Subject Matter

6. Claims 3 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

Art Unit: 3728

--"A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

-Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

8. Information about your application can be obtained at the PTO Home Page at www.uspto.gov. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Telephone inquiries regarding other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners" M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

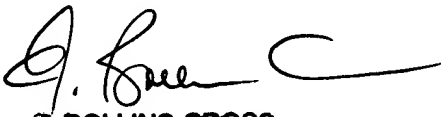
If in receiving this Office Action it is apparent to applicant that certain documents are missing, requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Art Unit: 3728

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached from 6AM - 4PM.


Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
March 23, 2004


E. ROLLINS-CROSS
GROUP DIRECTOR
TECHNOLOGY CENTER 3700